

REMARKS

Applicant has studied the Office Action dated August 18, 2004. No new matter has been added. It is submitted that the application, is in condition for allowance. By virtue of this amendment, claims 1-18 are pending. Reconsideration and further examination of the pending claims in view of the following remarks and enclosed 1.132 Affidavit is respectfully requested. In the Office Action, the Examiner:

- (1) Rejected claim 18 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement;
- (2) Rejected claims 1-17 under 35 U.S.C. 102(e) as being anticipated by Serbinis et al. (U.S. Patent No. 6,314,425 B1); and
- (3) Rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al. (U.S. Patent No. 6,314,425 B1), in view of Official Notice.

Telephonic Interview

As an initial matter the Applicants wish to thank the Examiner Grant for the telephonic interview of November 17, 2004. Discussed was the procedural options for claim 18 regarding the rejection under 35 U.S.C. §112, first paragraph to positively state the term is well known in the art. Also discussed was the inoperability of Serbinis for facsimile reception. An affidavit under 37 C.F.R. 1.132 is being filed concurrently herewith. The Applicant has declared that under MPEP §716.07, that the Serbinis reference can not operate to receive facsimile transmissions.

(1) Rejection Under 35 U.S.C. §112, First Paragraph

As noted above, the Examiner rejected claim 18 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. On page 2 of the Office Action, the Examiner states: *"It is assumed that this limitation is well known in the art."* The Applicant agrees. The Applicant affirmatively states: the term "speech to text" as used

in claim 18 is well known in the art. The Applicant respectfully requests that the Examiner's rejection under 35 U.S.C. §112, first paragraph be withdrawn.

Overview of the Current Invention

Preferred Embodiments of the present invention provide an improved system, computer readable medium, and apparatus for centrally managing documents in a client server system. The system includes database, a voice response system and a fax reception system to a telecommunications network. The present invention provides a novel combination of affordable scanning technology available through client fax machines, client telephone handsets, with web browsing to provide a centralized document storage and retrieval solution. Unlike prior art systems, the documents are loaded onto the centralized database storage using a fax machine and information or metadata which is associated with voice response. The present invention eliminates the need for an internet connection, client computer or other software such as a web browser. The combination of just a fax machine and a telephone makes it very easy for users to store fax images of documents in a database which is searchable by category and other user associated metadata. Turning to the summary of the present invention with emphasis added:

A user through the voice response system, provides a login request over the telecommunications network using a fax machine with a telephone. The system checks to determine if the user has an account, and if the user does not have an account setting up an account with the user over the telecommunications network. Next, the user via the voice response system provides a category to be associated with a document to be faxed from the user. The user faxes a document to be stored in the database that is associated with a category under an account for the user. To retrieve a document previously faxed for storage, the information relating to the document is searchable and the document can be faxed back to the user's fax machine.

In order to more particularly point out this feature of using a centralized database storage using a fax machine and information or metadata is associated using a telephone, the relevant language in the claims has been emphasized in the independent claims, i.e., claims 1, 10, 12, 14, and 16 as follows:

Claim 1. A method for centrally managing documents in a client server system comprising the steps of:

coupling to a server system with a database, one or more client systems over a network;

linking the server to a telephone system;

receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received;
and

storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

Claim 10. A method for centrally managing documents in a client server system comprising the steps of:

coupling to a server system with a database to a telephone system;

receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received;
and

storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one

document and the identifier is capable of being searched in the database.

Claim 12. A business method for centrally managing documents in a client server system comprising the steps of:

coupling to a server system with a database, a voice response system and a fax reception system to a telecommunications network;

using the voice response system, receiving a login request from a user over the telecommunications network using a client network unit;

determining if the user has an account and if the user does not have an account setting up an account with the user over the telecommunications network;

using the voice response system prompting the user for a category to be associated with a document to be faxed from the user using a voice response; and

receiving a fax from the user of a document to be stored in the database that is associated with a category under an account for the user.

Claim 14. A computer readable medium containing programming instructions for centrally managing documents in a client server system, the programming instructions comprising:

coupling to a server system with a database to a telephone system;

receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received; and

storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

Claim 16. A central fax storage and retrieval system for centrally managing documents over a telecommunications network:

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a server coupled to a telecommunications network;
a fax receiver coupled to the server for receiving faxes sent from a user's fax machine;
a telephone voice response system coupled to the server, the telephone response system having pre-recorded message prompts and voice recognition software for receiving user selections of the prerecorded message prompts, and the telephone response system receiving a message identifying a user; and
a database coupled to the server, the database capable of storing electronically faxes received from the user's fax machine along with user information including user selections and user identification.

Accordingly, it is respectfully submitted that the application and the claims are in condition for allowance. Reexamination and reconsideration of the application, are requested.

1.132 Affidavit

File herewith is an affidavit under 37 CFR 1.132 to declare the interoperability of the Serbinis reference. It is respectfully submitted that the following rejections of the claims using the Serbinis reference should be withdrawn:

- Rejected claims 1-17 under 35 U.S.C. 102(e) as being anticipated by Serbinis et al. (U.S. Patent No. 6,314,425 B1); and
- Rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al. (U.S. Patent No. 6,314,425 B1), in view of Official Notice.

The Serbinis DMS system is inoperable to receive and store previously created documents by a user's fax machine.

(2) Rejection Under 35 U.S.C. §102(e)

Although the Applicant respectfully submits that the statements made for the 1.132

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affidavit suffice to overcome the Examiner rejection, the following remarks are included to further clarify the present invention over Serbinis to place this case in proper condition for allowance or in the alternative for appeal. As noted above, the Examiner rejected claims 1-17 under 35 U.S.C. 102(e) as being anticipated by Serbinis et al. (U.S. Patent No. 6,314,425 B1). The Applicant respectfully traverses this rejection. The Examiner at pages 2-3 of the office action states "*Serbinis teaches a method [...] from a user's fax machine (col. 7, lines 58-65, teaches utilization of a system in an environment) in the database; receiving fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to an identifier...*". However, careful reading of Serbinis discloses a fax notification from the document management system, not a fax reception to the document management system. Or in the words of Serbinis at col. 7, lines 59-65 (Emphasis Added).

Notification information tables 66 maintain information necessary to generate a notification message, and include entries for: notification transport type, i.e., e-mail, facsimile, voice, or pager; information on the status of the notification, i.e. pending, sent, failed; the recipient's notification identification; priority information; and optionally, the scheduled date/time for delivery.

col. 19, lines 39-50 (Emphasis Added)

Notification Processes

Referring now to FIGS. 12A and 12B, the notification request and confirmation services available on a preferred embodiment of DMS system 17 are described. Notification messages are generated by notification server 35 in response to various user events. For example, when a registrant registers for a DMS service, the registrant receives a notification with instructions on authorization, as discussed hereinabove with respect to step 178 of FIG. 9.

As another example, when an Originator has created an electronic

document and uploaded that document to the DMS system, Authorized Users having access to the document may receive a notification that the document is available to be retrieved (as discussed with reference to steps 108 and 114 of FIG. 5). In this case, the notification may contain instructions on how the document may be retrieved from the DMS system. The notification messages are digital and may take the form of an alphanumeric message, digital sound, digital image or other digital forms. DMS system 17 therefore preferably supports several types of notification transports including e-mail, fax, voice messaging and pager.

In fact, there are only two places in the entire Serbinis reference referring to facsimile or fax as quoted above. Accordingly, the notification of users by fax from the DMS as explicitly described by Serbinis is not the same as receiving a document to be stored by fax. Serbinis teaches that the previously created documents are uploaded and stored from a client system to the DMS system using a client system with client software such as a web browser or applet. See Serbinis at col. 10, lines 20-23. In contrast in the present invention, the previously created documents are stored in the centralized database coupled to a server by "receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received." This receipt of the document by fax is patentably different over Serbinis. The Examiner is technically confounding transmission by the DMS of a fax notification with reception of a document for storage by fax.

Further, the Examiner at pages 10-11 of the Office Action states (Emphasis Added):

"At the top of page 14, Applicant argues that Serbinis is not applicable to the claimed feature for the reason that the notification of users by fax from the DMS is not the same as receiving a document to be stored by fax. While applicant's statement logically is true, namely that a notification of fax reception does not mean that there may be actual facsimile reception of a document. However, applicant's argument is not

believed to be correct in view of Serbinis and by what is known in the prior art.

The Applicant respectfully submits that this is not the correct standard for a rejection 35 U.S.C. 102(e) what *may be possible*.¹ The reference has to teach or describe that the DMS system receives documents using only a user fax machine along with the reception of associated document identifiers only by using a user telephone. Serbinis teaches fax notification based on when the document is available. This is not the same as storing documents on DMS. See Serbinis at co. 8, lines 59-64 and col. 19, lines 39-52.

The Examiner continues at pages 10-11 of the Office Action states (Emphasis Added)

At col. 7, lines 59-64, the administration table 64 maintains information necessary to generate a notification message and include entries for facsimile. For the management system to include an entry from a facsimile, it must be capable and operatively connected to a facsimile machine. At col. 7, lines 9-23, table 64 includes information regarding documents stored in memory 30. Col. 8, lines 48-57 refer to the actual document themselves. Because Serbinis suggest that present invention works in a facsimile environment it can be deduced that notification of a reception of a document.

The Examiner is correct in that Serbinis works in a facsimile environment for notification of a document being available. However, the Applicant respectfully submits that the Examiner continues to confuse the present invention's reception by facsimile into the document database with Serbinis' fax notification. Serbinis

¹ If, however, the Examiner's statements are based on facts within the personal knowledge of the Examiner, the Applicant respectfully requests that the Examiner support these references by filing an affidavit as is allowed under MPEP §707 citing 37 CFR 1.104(d)(2).

teaches the end-user using a web browser to upload the previously created document to the server not loading the server by receiving a fax transmission from a user's fax machine.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Serbinis.² The elements in independent claims 1, 10, 12, 14, and 16 recite "receiving a fax reception" and "storing the fax reception" on the centralized database for later retrieval. Accordingly, the present invention distinguishes over Serbinis for at least this reason. The Applicant respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

For the foregoing reasons, independent claims 1, 10, 12, 14, and 16 distinguish over Serbinis. Claims 2-9, 11, 13, 15, and 17 depend from claims 1, 10, 12, 14, and 16. Since dependent claims contain all the limitations of the independent claims, claims 2-9, 11, 13, 15, and 17 distinguish over Serbinis, as well.

(3) Rejection Under 35 U.S.C. §103(a)

Although the Applicant respectfully submits that the statements made for the 1.132 affidavit suffice to overcome the Examiner's rejection, the following remarks are included to further clarify the present invention over Serbinis and place this case in proper condition for allowance or in the alternative for appeal. As noted above, the Examiner rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al. (U.S. Patent No. 6,314,425 B1), in view of Official Notice. Independent claim 16

² See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

for the reasons above distinguishes over Serbinis because Serbinis is completely silent on

a fax receiver coupled to the server for receiving faxes sent from a user's fax machine;

a telephone voice response system coupled to the server, the telephone response system having pre-recorded message prompts and voice recognition software for receiving user selections of the prerecorded message prompts, and the telephone response system receiving a message identifying a user; and

a database coupled to the server, the database capable of storing electronically faxes received from the user's fax machine along with user information including user selections and user identification.

The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Serbinis reference expressly teaches away from receiving a document for storage via fax and instead describes notification via fax. Accordingly, independent claim 16 distinguishes over Serbinis and/or Official Notice for at least this reason.

Independent claim 16 distinguishes over Serbinis. Claim 18 depends from claim 16. Since dependent claims contain all the limitations of the independent claims, claim 18 distinguishes over Serbinis, as well.

CONCLUSIONS

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as previously amended.

In light of the Office Action, Applicant believes these arguments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the arguments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith to the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

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PLEASE, if for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call either of the undersigned attorneys at (561) 989-9811 should the Examiner believe a telephone interview would advance the prosecution of the application.

Respectfully submitted,

Date: November 18, 2004

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